

## Remarks

Claims 37-46 are pending in the application. New claims 47-49 have been added.

Claims 37-42, 45 and 46 stand rejected under 35 USC 103(a) as being unpatentable over published U.S. Patent Application No. 10/078,031 by **Leist** et al. (Pub. No. 2002/0179255) in view of U.S. Pat. No. 6,446,695 to **Forsland**. The Office Action also rejects Claims 37-46 under 35 USC 103(a) as being unpatentable over **Leist** in view of U.S. Pat. No. 6,586,085 to **Jella**. In addition, the Office Action rejects Claim 44 under 35 USC 103(a) as being unpatentable over **Jella** in view of **Forsland**. Claims 37, 40 and 43-46 have been amended. The Applicant respectfully traverses the rejections of claims 37-46, and presents new claims 47-49 for examination.

### **Claims 37-46 are Patentable over the Cited References**

#### **I. The Examiner Has the Burden to Establish a Prima Facie Case of Obviousness**

The Examiner has the burden to establish a *prima facie* case of obviousness when rejecting claims under 35 U.S.C. §103(a). See MPEP §2142 (8<sup>th</sup> Edition, Rev. 6). In making a rejection under 35 USC 103, the Examiner must clearly and explicitly articulate the reason(s) why the claimed invention would have been obvious to a person of ordinary skill in the art. See *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1740-41, 82 USPQ2d 1385, 1396 (2007). When rejecting a claimed invention as being obvious because the invention merely combines known elements according to known methods to yield a predictable result, or alternatively, because the invention includes the simple substitution of one known element for another to obtain a predictable result, the prior art relied upon must include each and every element claimed. See MPEP §§2143(A) and 2143(B).

#### **II. Claims 37-42, 45 and 46 are Patentable Over Leist in View of Forsland**

Claims 37-42, 45 and 46 stand rejected under 35 USC 103(a) as being unpatentable over published U.S. Patent Application No. 10/078,031 by **Leist** et al. (Pub. No. 2002/0179255) in view of U.S. Pat. No. 6,446,695 to **Forsland**. Specifically, the Office Action states that **Forsland** discloses a multi-paneled garage door that simulates double doors. The Office Action admits that **Leist** does not simulate “typical doors” as presently disclosed, but nevertheless

concludes that it would have been obvious to modify **Leist** to provide the overhead door with the appearance of the **Forsland** doors because both **Forsland** and **Leist** are concerned with decorative appearances and aesthetics. The Office Action states that modifications to the appearances taught by **Forsland** such as recited in Claim 45 would have been obvious as the “subject of design choice based purely on aesthetics.” Regarding Claim 46, the Office Action states that the term “portions” in the phrase “not more than two intersecting surface portions of the sheet metal skin” is extremely broad, and that the “presence of grooves or raised portions along the edges does not obviate there being only two intersecting portions.” The Applicant respectfully traverses the rejections of claims 37-42, 45 and 46 as discussed in detail below.

**a. Claims 37-39**

Independent Claim 37 (and each of depending claims 38 and 39) recites a metal overhead sectional garage door that includes “a plurality of pivotally connected horizontal door sections that each include a continuous sheet metal face panel,” and “a narrow vertical groove integrally formed in each of the sheet metal face panels that align with each other to form a narrow vertical recess that substantially continuously extends between the top edge and the bottom edge of the door when the door is in a closed position.” Neither **Leist** nor **Forsland** describes an overhead door that includes door sections formed of continuous sheet metal face panels each having a narrow vertical groove integrally formed in the sheet metal face panels that align with each other to form a narrow vertical recess that substantially continuously extends between a top edge and a bottom edge of the door when the door is in a closed position. Thus, the asserted combination of prior art references does not teach or suggest all the claim limitations. In addition, Claims 37-39 have been amended to require that the door include no separate overlays attached to one or more exterior surfaces of the sheet metal face panels. In contrast, **Forsland** describes a door that includes a plurality of separate overlays attached to the exterior faces of the door panels that form at least part of the door’s facade. Thus, **Forsland** teaches away from the claimed invention. At least for these reasons, the Office Action does not set forth a *prima facie* case of obviousness, and the rejection of claims 37-39 under 35 USC 103(a) should be withdrawn.

**b. Claims 40-42**

Independent claim 40 and dependent claims 41 and 42 each recite a metal overhead sectional garage door that includes a plurality of pivotally connected horizontal door sections,

each door section comprising a continuous sheet metal face panel, and a plurality of embossed patterns integrally formed in at least a portion of the sheet metal face panels, wherein at least a portion of the embossed patterns define at least one simulated wooden crossbuck frame member. Neither **Leist** nor **Forsland** disclose a door having sheet metal face panels that include a plurality of embossed patterns integrally formed in at least a portion of the sheet metal face panels, and wherein at least a portion of the embossed patterns define at least one simulated wooden crossbuck frame member. In an obviousness rejection under 35 USC 103(a), the prior art reference (or references when combined) must teach or suggest all the claim limitations. In addition, Claims 40-42 have been amended to require that the door include no separate overlays attached to one or more exterior surfaces of the sheet metal face panels. In contrast, **Forsland** describes a door that includes a plurality of overlays attached to the exterior faces of the door panels. Thus, **Forsland** teaches away from the claimed invention. At least for these reasons, the Office Action does not set forth a *prima facie* case of obviousness, and the rejection of claims 40-42 under 35 USC 103(a) should be withdrawn.

#### c. Claims 45 and 46

Independent Claim 45 recites an overhead garage door comprising an embossed pattern in a thin-walled face panel including an integrally-formed panel portion having a substantially planar portion including a plurality of spaced, parallel vertical grooves. The substantially planar portion substantially simulates the appearance of a non-metal panel formed by a plurality of assembled tongue-and-groove planks. The panel portion is substantially rectangular in shape, and includes a height and a width, the height being greater than the width. The Office Action states that modifications to the appearances taught by **Forsland** such as recited in Claim 45 would have been obvious as the “subject of design choice based purely on aesthetics.”

Neither **Leist** nor **Forsland** discloses a door having a panel that includes spaced and parallel vertical grooves, or a rectangular panel portion that is taller than it is wide. In an obviousness rejection under 35 USC 103(a), the prior art reference (or references when combined) must teach or suggest all the claim limitations. Accordingly, at least for this reason, the Office Action does not set forth a *prima facie* case of obviousness, and the rejection of claim 45 under 35 USC 103(a) should be withdrawn. In addition, the specification describes a simulated tongue-and-groove panel having a height that is greater than its width as follows:

As shown in Figure 2, the panel portion 200 of embossment pattern 110 has a height “H” and a width “W.” In certain embodiments of the invention, it is desirable for the embossed patterns in the door sections to be vertically oriented. The term “vertically-oriented” as used herein with regard to the embossment patterns means that height “H” is greater than width “W.” In particular, it is desirable for the embossed patterns to have a height-to-width ratio (H/W) of at least about 1.2. This vertical orientation of the embossed patterns also contributes to the vertically hung appearance of the sectional overhead garage door.

Accordingly, the inclusion of such vertically oriented embossed panels is not for the purpose of “aesthetics” as asserted by the Examiner, and instead, contributes to making the claimed door look like something it is not, *i.e.*, a plurality of vertically hung doors.

In addition, Claim 45 has been amended to require that the door include no separate overlays attached to one or more exterior surfaces of the thin-walled face panel. In contrast, **Forsland** describes a door that includes a plurality of overlays attached to the exterior faces of the door panels. Thus, **Forsland** teaches away from the claimed invention.

Claim 46 depends from Claim 45, and has been amended to more clearly recite the configurations of the upper and lower edges of the door sections. As amended, Claim 46 further recites two lowermost door sections that each includes a continuous sheet metal skin including a front wall, a top wall, and a bottom wall. The front wall and top wall intersect at an angle to form an upper corner, and the front wall and bottom wall intersect at an angle to form a lower corner. The upper and lower corners extend along the full width of the door section. A first elongated portion of the front wall that is immediately adjacent to the upper corner and extends along the full width of the door section is substantially flat and includes no substantial raised or recessed portions immediately adjacent to the upper corner. A second elongated portion of the front wall that is immediately adjacent to the lower corner and extends along the full width of the door section is substantially flat and includes no substantial raised or recessed portions immediately adjacent to the lower corner. Because the door sections disclosed in **Leist** and **Forsland** clearly include grooves and/or raised portions along their edges, the combination of **Leist** and **Forsland** does not include every limitation recited in Claim 46. In an obviousness rejection under 35 USC 103(a), the prior art reference (or references when combined) must teach or suggest all of the claim limitations.

Accordingly, at least for these reasons, the Office Action does not set forth a *prima facie* case of obviousness, and the rejection of Claims 45 and 46 under 35 USC 103(a) should be withdrawn.

### **III. Claim 44 is Patentable over Jella in view of Forsland**

The Office Action rejects Claim 44 under 35 USC 103(a) as being unpatentable over **Jella** in view of **Forsland**. Specifically, the Office Action states that it would have been obvious to modify **Jella** to include the vertical groove of **Forsland** to “further enforce the double door appearance.” Claim 44 has been amended to require that the thin-walled upper and lower face panels are integral portions of the rectangular door sections, and include no separate overlays attached to the face panels.

Claim 44 recites an overhead garage door including a substantially rectangular upper section with an integral thin-walled upper face panel having an upper front face including a first integrally-formed substantially vertical groove substantially extending between its upper and lower edges. Claim 44 further recites a substantially rectangular lower section including an integral thin-walled lower face panel having a lower front face including a second integrally-formed substantially vertical groove substantially extending between its top and bottom edges. The first and second substantially vertical grooves are substantially collinear when the garage door is in a closed position, and opposed portions of the upper and lower sections on either side of the first and second substantially vertical grooves are bilaterally symmetric with each other.

Unlike the garage door recited in Claim 44, both **Jella** and **Forsland** describe sectional garage doors with separate, non-integral overlays mounted on the outer faces of their door sections. Accordingly, neither **Jella** nor **Forsland** discloses rectangular upper and lower door sections with integral thin-walled face panels having integrally-formed substantially vertical grooves. Indeed, both **Jella** and **Forsland** teach away from a door without added overlays. Accordingly, at least for these reasons, the Office Action does not set forth a *prima facie* case of obviousness, and the rejection of claim 44 under 35 USC 103(a) should be withdrawn.

#### **IV. Claims 37-46 are Patentable over Leist in view of Jella**

The Office Action rejects Claims 37-46 under 35 USC 103(a) as being unpatentable over **Leist** in view of U.S. Pat. No. 6,586,085 to **Jella**. In particular, the Office Action states that it would have been obvious to modify **Leist** to include three door panels as taught by **Jella** “so as to eliminate an additional seam between panels and to reduce costs,” and to incorporate other outer surface features shown in Jella.

Regarding the modification of the steel door of **Leist** to include only three panels, the Applicant disagrees that such a modification to **Leist** would have been obvious in view of **Jella**. For example, as explained in U.S. Pat. No. 7,343,958 assigned to Amarr Company (the owner of the present application):

*Conventional sectional overhead garage doors typically include four or more pivotally connected door sections. Some newer sectional overhead door designs, however, may include only three door sections, such as the overhead doors described in co-pending U.S. patent application Ser. No. 10/699,749, filed Nov. 3, 2003. Such three-section doors tend to have a height-to-weight relationship that is substantially non-linear when compared to the substantially linear height-to-weight relationship for four-panel doors. Especially when such three-panel doors are provided with one or more reinforcement struts like those described above, a substantially nonlinear door height/weight relationship like that shown in FIG. 5 results.*

*Known substantially linear garage door lift systems like those described above are incapable of providing variable upward-acting forces to adequately counterbalance the non-linear change in door weight associated with changes in door elevation for wind-resistant, strut-reinforced doors overhead doors and/or doors comprised of three sections. Accordingly, there is a need for a door lift system that accommodates this non-linear variability in door lift forces such that a substantially constant applied vertical load is sufficient to raise such a door.*

(Col. 4, lines 12-34). Accordingly, producing a steel sectional overhead garage door having three rather than four or more sections or panels presents special technical challenges that must be overcome, and would not have been obvious at the time of the invention.

In addition, even if one assumes that it would have been obvious to make the door of **Leist** in three sections in view of **Jella** (which the Applicant does not hereby admit), the combination of **Leist** and **Jella** does not include every element recited in any one of Claims 37-

46 for at least the same reasons stated above regarding the asserted combinations of **Leist** and **Forsland**, and **Jella** and **Forsland**, and/or **Leist** and **Jella**. For example, neither **Leist, Forsland** nor **Jella** discloses an overhead door that includes door sections formed of continuous sheet metal face panels having narrow vertical grooves integrally formed in the sheet metal face panels that align with each other to form a narrow vertical recess that substantially continuously extends between a top edge and a bottom edge of the door when the door is in a closed position as recited in Claims 37-39. In addition, neither **Leist, Forsland** nor **Jella** discloses a door having sheet metal face panels that include a plurality of embossed patterns integrally formed in at least a portion of the sheet metal face panels, and wherein at least a portion of the embossed patterns define at least one simulated wooden crossbuck frame member as recited in Claims 40-42. Furthermore, neither **Leist, Forsland** nor **Jella** discloses a door having a panel that includes spaced and parallel vertical grooves, or a rectangular panel portion that is taller than it is wide as recited in Claims 43, 45 and 46, or door sections without grooves or raised portions along their edges as recited in Claim 46. Regarding Claim 44, neither **Leist, Forsland** nor **Jella** discloses rectangular upper and lower door sections with integral thin-walled face panels having integrally-formed substantially vertical grooves. In addition, all of Claims 37-46 require that the faces of the door sections include no overlays. Both **Jella** and **Forsland** actually teach away from a door without added overlays. Accordingly, at least for these reasons, the Office Action does not set forth a *prima facie* case of obviousness, and the rejection of claims 37-46 under 35 USC 103(a) should be withdrawn.

**V. Even if the Office Action Establishes a Prima Facie Case of Obviousness**  
**(Which It Does Not), There is Substantial Evidence of Nonobviousness.**

Objective evidence or secondary considerations such as unexpected results, commercial success, long-felt need, failure of others, copying by others, licensing, and skepticism of experts are relevant to the issue of obviousness and must be considered in every case in which they are present. See MPEP §2141. When evidence of any of these secondary considerations is submitted, the examiner must evaluate the evidence. The weight to be accorded to the evidence depends on the individual factual circumstances of each case. See *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); and *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ 81 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 947

(1987). The ultimate determination on patentability is made on the entire record. See *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

The Applicant reminds the Examiner that ample evidence of nonobviousness has already been submitted in connection with the present application via the Declaration of Loren Mock. The previously submitted Declaration of Loren Mock sets forth substantial objective evidence of non-obviousness, including substantial evidence regarding satisfaction of a long-felt need, commercial success of the invention, and prompt copying of the invention by others. In addition, the Declarations of Richard A. Brenner, Ronald S. Nelson, Bruce R. Knoblich, Tom Donahue, and Lawrence F. Notto submitted herewith present additional substantial evidence of nonobviousness. In particular, these Declarations include evidence that the invention recited in the claims has attained substantial commercial success, and that the commercial success of the invention is substantially and directly attributable to the aspects and features of the invention recited in the pending claims, and not other factors, such as extensive advertising.

An applicant who is asserting commercial success to support a contention of nonobviousness bears the burden of proof of establishing a nexus between the claimed invention and evidence of commercial success. See MPEP §716.03. The Federal Circuit has acknowledged that an applicant bears the burden of establishing such a nexus, stating:

In the *ex parte* process of examining a patent application, however, the PTO lacks the means or resources to gather evidence which supports or refutes the applicant's assertion that the sale constituted commercial success. *Cf. Ex parte Remark*, 15 USPQ2d 1498, 1503 (Bd. Pat. App. & Int. 1990)(evidentiary routine of shifting burdens in civil proceedings inappropriate in *ex parte* prosecution proceedings because examiner has no available means for adducing evidence). Consequently, the PTO must rely upon the applicant to provide hard evidence of commercial success.

Id. (quoting *In re Huang*, 100 F.3d 135, 139-40, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996)). Objective evidence of nonobviousness, including commercial success, must be commensurate in scope with the claims. See MPEP §716.03(a).

The Declaration of Richard Brenner, submitted herewith, and the previously submitted Declaration of Loren Mock, include substantial evidence of commercial success. Specifically,



since the introduction of the SCH door by Amarr, sales of the SCH door as a percentage of Amarr's total residential garage door sales have steadily increased. See Brenner Declaration at ¶ 7. The table below from the Brenner Declaration shows the sales of Amarr's SCH door as a percentage of Amarr's total residential garage door sales for each fiscal year between 2004 and 2008:

	FY2004*	FY2005*	FY2006*	FY2007*	FY2008*
SCH Door Sales as a Percentage of Amarr's Total Residential Garage Door Sales	0.5	7.2	11.7	14.4	15.0

(\*) Amarr's fiscal year extends from July 1 to June 30.

See *Id.*

In addition, the Declarations of Loren Mock, Richard Brenner, Ronald Nelson, Bruce Knoblich, Tom Donahue, and Lawrence Notto include evidence of a substantial nexus between the claimed invention and its commercial success. For example, the Declaration of Ronald Nelson, President of Pioneer Overhead Door ("Pioneer"), includes evidence of such a nexus. As stated in the Nelson Declaration, Pioneer is in the business of selling and installing residential garage doors. See Nelson Declaration at ¶ 1. Mr. Nelson's duties at Pioneer include general manager, sales manager, controller, and foreman, and he has worked in the building products and home improvement industry for 30 years. See *Id.* Amarr has supplied garage doors to Pioneer since at least 1993. See *Id.* at ¶ 2. As stated in his Declaration, Mr. Nelson is familiar with the SCH doors supplied to Pioneer by Amarr under Amarr's CLASSICA™ brand. See *Id.* at ¶ 3. Mr. Nelson is also familiar with the various types of residential garage doors that are generally available in the industry, including steel doors, wooden doors, and doors having separate overlays or facades mounted on their exterior faces. See *Id.*

Mr. Nelson's Declaration states that since 2003, Pioneer has purchased over \$1,000,000.00 of Amarr's SCH doors for resale to Pioneer's customers, and that Pioneer made the decision to purchase Amarr's SCH doors over previously known types of metal overhead garage doors because Amarr's SCH doors combined all of the benefits of metal overhead garage doors (including durability, affordability, ease of use, overhead stowage, etc.) with the attractive simulated appearance of traditional wooden carriage house doors. See Nelson Declaration at ¶ 4.

Mr. Nelson further declares that his Company prefers the Amarr SCH doors over other commercially available residential metal overhead garage doors, because the Amarr doors incorporate several features which give the doors a superior simulated appearance of traditional carriage house doors. See *Id.* at ¶ 5. Mr. Nelson further states that these features include, but are not limited to:

- a. visually apparent vertical grooves in the face of each door section that align with each other when the SCH door is closed, thus providing the visual appearance of a vertical separation or gap between adjacent swinging door panels when the doors are closed;
- b. bilateral symmetry of the embossed patterns in each door section on either side of the aforementioned vertical grooves, whereby the combination of the embossed patterns of the multiple door sections also are bilaterally symmetric about the aligned vertical grooves of the door sections when the door is closed;
- c. portions of the face of the closed door on either side of the aligned vertical grooves are substantially taller than they are wide, thus simulating a pair of vertically hung swinging doors;
- d. embossed patterns in the door sections that visually simulate doors of entirely wooden construction, including simulated wooden rails, simulated wooden stiles, and simulated inset wooden panels having a plurality of spaced vertical grooves that provide the appearance of a plurality of tongue-and-groove boards assembled together side-by-side
- e. simulated wooden crossbuck members embossed in at least some of the door panels that align with other simulated wooden crossbuck members embossed in adjacent door panels that combine to provide the simulated appearance of a single continuous wooden crossbuck member;
- f. embossed patterns that simulate inset raised panels that are substantially taller than they are wide, and thus provide the door with a substantially vertical visual emphasis when the door is closed;
- g. three metal door sections rather than four or more (as in previous metal garage doors), thus minimizing the number of horizontal separations in the face of the door when

closed, contributing to the visual appearance of continuous vertical door panels, and permitting taller embossed patterns in the taller door sections; and

h. door panel top and bottom edges formed by the intersection of not more than two intersecting surfaces, thus providing a smooth and continuous transition between adjacent door sections when the door is closed that substantially masks the existence of any vertical separations between adjacent door sections.

See *Id.* at ¶ 5. In addition, Mr. Nelson states in his Declaration that the Amarr SCH door provides his Company's customers with an affordable alternative to expensive wooden garage doors, and provides his customers a durable and user-friendly door having the classic look of a traditional, wooden carriage house door. See *Id.* at ¶ 6. Additional evidence of a nexus between the claimed invention and its commercial success is presented in the Declarations of Tom Donahue, Bruce Knoblich, and Lawrence Notto.

Furthermore, as indicated by the Declaration of Richard Brenner, the substantial sales and the substantial annual increases in sales of Amarr's SCH door are not attributable to substantial advertising expenditures or substantial increases in advertising expenditures. See Brenner Declaration at ¶ 8. To the contrary, Amarr's SCH doors have been advertised exclusively via a limited number of print advertisements. See *Id.* Set forth below is a chart from the Brenner Declaration showing Amarr's advertising expenditures for the SCH door as a percentage of Amarr's total sales for each of the fiscal years 2003 to 2008:

	FY2004	FY2005	FY2006	FY2007	FY2008
SCH Door Advertising Expenditures as a Percentage of Total Sales	0.0095%	0.0331%	0.023%	0.0158%	0.00015%

See Brenner Declaration at ¶ 8.

In summary, the submitted evidence includes evidence of the substantial commercial success of the claimed invention since its introduction in 2004, and evidence of a clear connection or nexus between such commercial success and the claimed features of the invention.

Accordingly, even if the Office Action establishes a *prima facie* case of obviousness (which it does not), the claims should be allowed in view of such objective evidence of non-obviousness. Therefore, the Applicant respectfully requests that the rejections of claims 37-46 under 35 USC 103(a) be withdrawn, and that claims 37-49 be allowed in the application.

### Conclusion

The Applicant believes that claims 37-46 are in condition for immediate allowance, and such action is respectfully requested. In addition, the Applicant believes that new claims 47-49 are patentable over the prior art of record. If any issue remains unresolved, Applicant's attorney welcomes a telephone call from the Examiner to expedite allowance of the claims.

Respectfully submitted,

**Jeffrey R. McFadden**

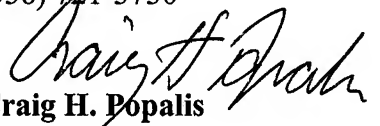
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